Supreme Court, U.S.
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No. 01-911

In The

Supreme Court of the United States

ASHOK TANKHA,

Petitioner,

v.

WYETH-AYERST LABORATORIES, INC., A DIVISION OF AMERICAN HOME PRODUCTS CORPORATION and FRED HASSAN, PRESIDENT OF WYETH-AYERST LABORATORIES, INC., and MARSAM PHARMACEUTICALS, INC., and MARVIN SAMSON, PRESIDENT OF MARSAM PHARMACEUTICALS, INC.,

Respondents.

On Petition For Writ Of Certiorari To The Supreme Court Of Pennsylvania

REPLY BRIEF OF PETITIONER

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4 pp

Respondent Wyeth's Brief in Opposition claims that the current manufacture of Premarin, its premier conjugated estrogen pharmaceutical, is essentially unrelated to any of the expired federal patents for conjugated estrogen. Brief in Opp. at 6-9. Nevertheless, Wyeth obtained a state court decree that prohibits use of those expired patents and it now concedes to this Court that "[t]he incidental consequence of that [state court] decree is that it necessarily restricts his [Petitioner's] ability to practice certain expired patents." *Id.* at 9. Obviously the expired patents are not totally unrelated.

Wyeth's assertions underscore a serious threat to federal patent hegemony, especially in the socially important realm of generic pharmaceuticals. Its acknowledgment that there was some encroachment by the state court decree upon the free use of expired patents confirms the high public importance of the issue presented by the Petition.

Petitioner submits that Wyeth, a former patent owner, must not be allowed to seek or obtain in state court any injunctive decree that restricts the federal right to use an expired patent. To allow former patent owners to pursue such decrees in state court would erode the federal right conferred upon society to make the product disclosed by the expired patent and would invite extensions of the patent monopoly under the rubric of "trade secrets." Allowing state courts, who are generally lacking in patent expertise and jurisdiction, to determine whether and when federal patent law may be sacrificed for the sake of inevitably variable "trade secret" interests runs against the overwhelming course of this Court's precedents.

Wyeth also makes copious reference to the fact-findings that Wyeth proposed and won from the state trial court to the effect that Petitioner posed a risk of revealing trade secrets and not limiting himself to the manufacture of generic drugs identical to what was disclosed in expired patents.[1] These bench findings, however, are not only irrelevant to the issue of federal patent supremacy, they are inherently unreliable because they beg the central question whether Petitioner possessed a federal right to use the expired patents free of any state law restriction. Petitioner submits that the state court's findings were premised in part on a misapprehension of his federal rights. The circumstantial evidence of Petitioner's conduct, briefly alluded to in the Petition, would appear in an entirely different light if his federal right to use expired patents were honored rather than viewed suspiciously by a forum more experienced in trade secret protection than protection of patent policy.

This Petition presents a compelling opportunity to address whether the owner of an expired pharmaceutical patent may actively seek and obtain in state court an injunction curtailing another's use of that patent long

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[1] The evidence used to support these inferences was presented by Wyeth substantially through its officials and in-house experts. Wyeth had also won from the state trial judge a reprieve from producing documents that would have assisted Petitioner in testing the true scope of the alleged trade secrets. Other issues, such as Wyeth's shredding of some documents it found in the office used by Petitioner, were decided in state court against Petitioner and are discussed in the trial court's Opinion beginning at 37a. Such were the vagaries of the state forum litigation. Only the federal patent issue, however, need be addressed by this Honorable Court.

after the patent monopoly has been enjoyed and exhausted.

WHEREFORE, Petitioner respectfully requests that this Honorable Court grant Petitioner a writ of certiorari to the Supreme Court of Pennsylvania.

Respectfully submitted,

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